

## REMARKS

Claims 1, 4-5, and 7-41 are pending. Applicants have amended claims 1, 8-11, and 16-20; and added new claim 42.

In claim 1, applicants added the word “and” before the last moiety of the Markush groups for R<sup>1</sup> and R<sup>2</sup> and added the language “each of which maybe” into the claim for purposes of clarity.

In claim 8, applicants added “H” back into the definition of R<sup>1</sup>, which was inadvertently removed previously. Support for “H” is located in claim 1 and the original claims.

In claim 9, applicants added a space between the word “claim” and the number “1.”

In claim 10, applicants corrected the typographical error “4-benzyloxy, 3-methoxy phenyl” to properly read “4-benzyloxy-3-methoxy-phenyl.” Support for the correct moiety is located, for example, on the third compound of claim 41.

In claim 11, which depends from claim 1, applicants have removed species that are not embraced by the genus of claim 1.

Claims 16-20 have been withdrawn from examination as being directed to non-elected subject matter. To place the claims in condition for rejoinder, applicants have amended them into “method” claims because “use” claims are not allowed under U.S. patent practice.

New claim 42 depends from claim 1 and is directed to compounds wherein R<sup>1</sup> is selected from the group consisting of: 2-(piperidin-1-yl)-ethyl, 2-(pyrrolidin-1-yl)-ethyl, 2-diethylamino-ethyl, and 3-dimethylamino-2,2-dimethyl-propyl. Support for claim 42 is located in genus of claim 1, the species of claim 11, and the specification on page 4, lines 5-13. New claim 42 requires all the limitations of claim 41. Therefore, its entry is kindly requested.

No new matter has been added into the claims.

### **Response to Claim Objection**

Claim 9 has been objected to for lacking a space between the word “claim” and the number “1.” Applicants have amended claim 9 by inserting an appropriate space. Accordingly, the objection no longer applies and should be withdrawn.

### **Response to Rejection Under 35 U.S.C. § 112**

Claims 1, 4-5, 7-12, and 41 have been rejected under 35 U.S.C. § 112, second paragraph, for lacking clarity.

Claim 1 has been rejected for lacking an “and” before the word “heteroarylalkyl” in the Markush listing of R<sup>1</sup> and R<sup>2</sup>. Applicants have amended claim 1 to include an appropriate “and” in the Markush listings of R<sup>1</sup> and R<sup>2</sup>, thereby obviating the rejection.

Claim 11, which depends from claim 1, has been rejected for including species that are not embraced by the genus of claim 1. Applicants have amended claim 11 without prejudice or disclaimer to remove the species identified as falling outside the scope of claim 1, thereby overcoming the rejection. Applicants reserve the right to pursue the deleted compounds in the future.

### **Response to Double Patenting Rejection**

Claims 1, 4-5, 7-12 and 41 remain provisionally rejected over claims 85-108 of U.S. Patent Application No. 12/065,989 based on the non-statutory prohibition against obviousness-type double patenting. U.S. Patent Application No. 12/065,989 was filed *after* the instant application and therefore the instant application should be allowed to issue absent a terminal disclaimer when no more rejections remain. MPEP § 804(I)(B)(1) explains that:

If a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed

application to issue as a patent without a terminal disclaimer. . . If ‘provisional’ ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer.

Accordingly, the obviousness-type double patenting rejection should be withdrawn and the instant application allowed to issue.

**Rejoinder**

Claims 1, 4-5, 7-12, and 41-42 (claims directed to compounds and compositions) are in condition for allowance. Accordingly, applicants hereby exercise their right of rejoinder of claims 13-40 (claims directed to methods of using the compounds and pharmaceutical compositions of claims 1, 4-5, 7-12, and 41-42). *See MPEP § 821.04.*

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 14090-00003-US1 from which the undersigned is authorized to draw.

Dated: January 15, 2010

Respectfully submitted,

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